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10/615,726	07/09/2003	John B. Freese	0212.67070	1792

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/615,726	Applicant(s) FREESE ET AL.	
	Examiner Shelley Self	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 32-49 is/are pending in the application.
 4a) Of the above claim(s) 23-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 1-22, 32-37, 40 and 44-49 is/are rejected.
- 7) ☐ Claim(s) 41-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the invention of Group I (clms. 1-22, 29-31 and 38-43) in the reply filed on January 21, 2005 is acknowledged. The traversal is on the ground(s) that the invention of Group I is drawn to both a plunge and fixed base router and is therefore generic. This is found persuasive; therefore the inventions of Groups III and IV (clms. 32-37, 44-49) are included in that of the invention of Group I and an action on the merits follows.

Claims 29-31 were inadvertently listed with Group I, however the subject matter of claims 29-31 is that of Group II, claims 23-28. Accordingly, claims 29-31 are separable and distinct from the invention of Group I as being directed to a plunge router combination having the specifics of an indicator.

Accordingly, claims 23-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 21, 2005.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor* (clms. 1, 32, 38, 44) and *bit* (clm. 34) must be shown or the feature(s) canceled from the claim(s).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "60" and "62" have both been used to designate a sub-base assembly (pg. 7, lines 2, 21). Additionally, the drawings are objected to because reference character "68" has been used to designate both a lock lever (pg. 7, line 17) and a handle (g. 7, line 20), reference character "106" has been used to designate both angular corner portions (pg. 9, line 15) and a recess (pg. 10, line 3), reference character "194" has been used to designate both a base release actuator (pg. 14, lines 8, 9) and a shoulder screw (pg. 14, lines 12). The specification and drawings should be reviewed to ensure all elements are correctly annotated with the appropriate reference characters. No new matter should be entered.

Further, regarding page 11 of the specification, lines 13-18 are particularly confusing. For example, the specification states the "*...the threaded rod 144 ...extends through opening 146 and is threaded through a fitting 148 to engage the left post 138.*" However, figure 8 clearly depicts the plunge locking mechanism 66, plunge lock lever 68, threaded rod 144 and opening 146 on the right side portion of the apparatus, while figure 17 illustrates the post (138) on the left side portion of the sub-base 62. It is unclear how the plunge locking mechanism and it's components relate to the post 138 in the drawings. Further, per figure 8, the threaded rod 144 does not appear to be extended through fitting 148. Clarification is required.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 and 40-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claim 1, neither the specification nor the drawings provide support for a hybrid router comprising a fixed base assembly and a plunge base assembly. The specification appears to provide support for a hybrid router capable of functioning in either a fixed base or plunge base assembly, however there is no support as to how fixed base and plunge base assemblies are interconnected this arrangement has not been described in detail, nor do the drawings provide support for such.

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For example, figure 2 is drawn to a plunge base assembly router, figure 3 is drawn to a fixed base assembly router, it is unclear how the two (i.e., fixed and plunge base assemblies) function together. Accordingly, the disclosure is inadequate.

With regard to claim 40, the parent claim 38 clearly states a plunge base assembly, however claim 40 recites, “...*relatively thin wall around the circumference thereof*...”; neither the specification nor the drawings provide support for such arrangement. Moreover both the specification and drawings (figs. 19-23) define a thin wall segment to be associated with that of the fixed base assembly. Clarification is required.

Therefore the equivalents of the prior art could not be ascertained; accordingly no art has been applied to claims 1-22.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22, 34-37 and 40-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, no cooperative mechanical critical structure has been positively recited as it relates the fixed base assembly and the plunge base assembly. For example, it is unclear how the elements of the fixed base assembly relate to the elements of the plunge base assembly, i.e., the claim appears to be aggregate in nature and merely lists elements. Clarification is required.

Claim 34 is particularly confusing, rendering a clear understanding of the claimed invention difficult. For example, the claim states, “...*said first motor assembly locking*”

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mechanism comprising: an elongated live hinge...a clamp lever..."; however per the specification these elements relate to the motor carrier assembly locking mechanism (fig. 8) for the plunge base assembly. Lines 6 and 7 of the claim clearly define the invention to be that of a fixed base assembly.

Further regarding claim 34, lines 8 and 9 state, "*said first motor assembly locking mechanism*" and line 10 states, "*said one thin wall segment*"; there are insufficient antecedent bases for these limitations within the claim. Examiner suggests, --*said one relatively thin wall segment*—

As to the recitation of "*said first motor assembly locking mechanism*" (clm. 34), it is unclear if this refers to the motor assembly locking mechanism positively recited in the parent claim 32 or if it is another separate element. Clarification is required.

Regarding claims 34 and 40, the term, "*...at least one segment of relatively thin wall around the circumference...*" is relative and therefore unclear. For example it is not clear what thin wall, is, i.e. thin compared to what or as it relates to what? Clarification is required.

With regard to claims 34-37, a clear understanding of the claimed invention could not be ascertained; accordingly no prior art has been applied.

Claim 40, recites, "*said second motor assembly locking mechanism comprising...*" (line 8), there is insufficient antecedent basis for this limitation within the claim. Furthermore, no first motor assembly locking mechanism has been positively recited. The recitation of a second implies a first must exist. Clarification is required.

Also regarding claim 40, the term, “relatively thin wall” does not have support in the specification with a plunge base assembly and as defined by the specification (pg. 17, lines 7, 13) relates to a fixed base assembly. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 33 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Coffey (5,913,645). With regard to claims 32, 44 and 46, Coffey discloses a router comprising a motor assembly (42) having a housing containing a motor (fig. 1; col. 3, lines 10-11) for driving an output shaft (49) to which a bit holding mechanism (50) can be attached, operating handles (20) attached to said housing (Examiner notes that the handles 20 are attached to the housing via the base assembly 10) for use by an operator, and operating controls (44) for operating said motor; and a fixed base assembly (10) into which said motor assembly can be removably installed (figs. 1, 4; col. 1, lines 23-28, 61-65), said fixed base assembly(10) having a planar bottom surface (14), a depth adjustment mechanism (86) and a motor assembly locking mechanism (24,30,32,34) for locking said motor assembly in said fixed base assembly(col. 2, lines 62-67).

With regard to claims 33, 45 and 47 Coffey discloses a depth adjustment controller that controls the depth of cut of a bit when said motor assembly is installed in said fixed base

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assembly (col. 34-42), wherein said depth adjustment controller comprises knob (86) that is located on the top of one side of the motor assembly housing (fig. 3), rotation of the knob causing the depth of cut to be increased or decreased depending upon the direction of the rotation (col. 3, lines 39-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coffey (5,913,645) in view of Long et al. (6,419,429). Coffey does not disclose handles having a generally horizontal shoulder portion which merge with a generally vertical grip portion. Long teaches in a similar art a router having a motor, housing and base assembly, wherein the router apparatus has handles with a generally horizontal portion merging with a vertical grip portion (16). Long teaches this construction to be ergonomically desirable to the user. Further Long teaches that this particular construction of handles can be used on both fixed and plunge base routers (col. 2, lines 26-27). Accordingly, because the reference are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replaced Coffey's handle construction with one having horizontal shoulder portions and vertical grips for improved ergonomic characteristics as taught by Long.

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Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coffey (5,913,645) in view of Long et al. (6,419,429) as applied to claim 48 above, and further in view of Pientka et al.(6,726,414). Neither Coffey nor Long discloses the operating controls including an on/off motor switch located in one of said handles. It would have been obvious to one having ordinary skill in the art at the time of the invention to construct Coffey with the control switch (44) in a handle, because merely rearranging parts of an invention does not in itself warrant patentability and involves only routine skill in the art. See *In re Japikse*, 86 USPQ 70.

Moreover, Pientka teaches in a similar art a router having a fixed based construction wherein a motor housing (16) is vertically movable with respect to a fixed base assembly (26). Further Pientka teaches the use of control switches (38) within a handle portion (34) of the router apparatus. Pientka teaches this construction for ease of controlling, i.e., powering on/off the router. Because the references are from a similar art it would have been obvious at the time of the invention to one having ordinary skill in the art to relocate Coffey's switch (44) from the motor housing to the handle as taught by Pientka for improved operator control of the router.

Allowable Subject Matter

Claims 38 and 39 are allowed.

Claims 41-43 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:
The prior art of record does not disclose a motor assembly locking mechanism for removably

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locking said motor assembly in said motor carrier assembly in combination with the rest of the claimed limitations as set forth in claim 38. Long discloses a router comprising a motor assembly (12) having a housing (18) containing a motor (col. 2, lines 29-33) for driving an output shaft (22) to which a bit holding mechanism (24) is attached, operating handles attached to said housing (16) for use by an operator, and operating controls (38) for operation of said motor; a plunge base assembly (14) having a motor carrier assembly and a sub base (28) structure having a planar bottom surface (30) and a pair of spaced vertical guide posts (32) along which said motor carrier assembly can be vertically moved (fig. 1). Long discloses a plunge locking mechanism (36) for holding said carrier assembly at a particular vertical position along said guide posts (32). Long does not disclose a motor assembly locking mechanism for removably locking said motor assembly in said motor carrier. Long is silent to any removability of the motor assembly from the motor carrier. Accordingly, Long neither anticipates nor renders obvious the claimed invention as set forth in claim 38.

Neither the prior art of record, nor any combination thereof discloses the claimed invention as set forth in claim 38. Accordingly, claims 38 and 39 are allowable over the prior art of record.

Claim 40 would be allowable if rewritten to overcome the 35 U.S.C. 112 rejection(s).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

April 27, 2005



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